

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2095.004100/P3073US1

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on _____

Signature _____

Typed or printed name _____

Application Number

10/612,632

Filed

July 1, 2003

First Named Inventor

Michael Stochosky

Art Unit

2443

Examiner

Jerry B. Dennison

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Jaison C. John/

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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Registration number if acting under 37 CFR 1.34 _____

September 30, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☒ *Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: MICHAEL STOCHOSKY

Group Art Unit: 2143

Serial No.: 10/612,632

Examiner: Jerry B. Dennison

Confirmation No.: 3652

Atty. Dkt.: 2095.004100

Filed: July 1, 2003

Client Ref.: P3073US1

For: PEER-TO-PEER ACTIVE CONTENT SHARING

CUSTOMER NO.: 62293

REMARKS CONCERNING PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP APPEAL BRIEF- PATENT

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Sir:

Appellant submits the following remarks concerning the Pre-Appeal Brief Request for Review filed concurrently herewith. The following remarks show that there are clear errors in the Examiner's rejections.

Claim Rejections Under 35 U.S.C. §101 – The Examiner rejected claim 1 for having recited a system comprising a sender peer and a recipient peer, wherein each peer comprises modules. The Examiner asserted (for the first time) in the Final Office Action (dated June 30, 2009) that because the Specification recites that “in general, a peer is some type of computing device (physical or virtual),” the claim is allegedly strictly software due to the reference to the “virtual” description. However, Examiner's own assertion indicates that the disclosure in the Specification recites that the computing device may be **physical**. Further, virtual components may also be linked with physical components and satisfy statutory requirements. Nevertheless, the Specification clearly describes that a peer may be a “physical device.” Since it is undisputed that the “sender peer” includes an embodiment that is described to be physical, it is of proper statutory subject matter. In order to expedite prosecution, Appellant amended the rejected claims to recite: “a device including a sender peer” and “a device including a recipient peer” (claims 1-21) as well as “a device” (claims 42-44). A device is clearly statutory subject matter, in addition to the sender and recipient peers being statutory subject matter.

The Examiner, however, argued in the Advisory Action (dated Sept. 11, 2009) that “‘devices’ may be virtual as well.” See Advisory Action, Continuation Sheet. The Examiner's reasoning is inapplicable to a §101 rejection at least because a “device” is statutory subject matter and because, contrary to the Examiner's assertion, claim 1 does not call for a device that

is “simply made up of a virtual peer.” *See* Advisory Action, Continuation Sheet. Claim 1 recites: “a device including a sender/recipient peer,” not simply a device that is a virtual peer, as argued by the Examiner. The substance of the claim aside, the Examiner has severely mischaracterized the claim language by attempting to impose a closed-type claim format. In fact, the device called for in claim 1 includes a sender/recipient peer (*i.e.*, the device is **not** to just a peer, as the Examiner contends); the phrase “includes” implies an open claim construction not limited to express terms included therein. Thus, Appellant asserts that “a device” is statutory subject matter, as in claim 1, and the Examiner has mischaracterized the claims and incorrectly applied the §101 standard.

Claim Rejections Under 35 U.S.C. §102 – In the Advisory Action, the Examiner indicated that “Applicant agreed in the interview dated 4/06/2009 that the claims do not show [the] feature of outputting both the text for chatting and the active content on a single path.” *See* Advisory Action, Continuation Sheet. Appellant respectfully asserts that the Examiner has mistakenly, no doubt, misconstrued Appellant’s statements during the Examiner Interview. Appellant did not, and has never, stated that the features recited in claim 1 of the instant Application do not send both the active content and chat communications using a chat module communications path. In fact, these features have been expressly argued (in the affirmative) by Appellant during the prosecution (and Examiner Interview(s)) relating to the instant Application. Further, the Examiner’s Interview Summary (dated April 6, 2009) makes no mention of the alleged agreement by Appellant, as set forth by the Examiner in the Advisory Action. In fact, the Examiner’s Interview Summary explicitly states: “Focus was made regarding Applicant’s intentions that the active content as well as the text for chatting between the sender and receiver were occurring along the same path.” *See* Examiner Interview Summary (dated April 6, 2009), page 2. As such, the Examiner’s comments in the Advisory Action are inconsistent, and are factually incorrect.

During the Examiner Interview, Appellant *did* agree that the *Lee* reference does not teach sending active content along the same path as chat module communications. This is clear at least from *Lee*’s disclosure and Fig. 2; separate paths are used for active content/chat communications.

In the Advisory Action, the Examiner argues that claim 1, as pending in this Appeal, does not teach sending chat communications and active content along the same path. *See* Advisory Action, Continuation Sheet. The Examiner argues that the features recited in claim 1

only call for a path to send active content. *Id.* Appellant disagrees with the Examiner's position at least because the claimed feature of "a chat module communications path" is used to transfer chat communications as well as active content. A person of skill in the art would recognize that a chat module communications path is the path used by chat modules to convey chat messages to each other. In other words, not only is a chat module communications path, as is self-evident from the term, a communications path used by chat modules, but this path is used to convey chat messages. Appellant respectfully directs the Examiner's attention to the Specification, ¶[0047]: "The communications module 310 provides a communications pathway for the chat module 210 to transmit messages, and to share active content and identity-based activity through the network 145." As defined in the Specification, the communications path of the chat module(s) is used for transmitting chat messages **and** sharing active content. It should be noted that Appellant is not importing features from the Specification into the claims. Rather, Appellant points out that the communications path between chat modules is *explicitly defined* in the Specification as transmitting chat messages and active content. As such, when Appellant recites "a chat module communications path," as used in claim 1, such a path, by definition, transmits chat messages.

Claim 1 calls for the first chat module adapted to send the active content using a chat module communications path. As discuss above and defined in the Specification, the chat module communications path is the path used, by the chat modules, to transmit chat messages. *Lee* explicitly teaches different/separate paths for chat module communications and content sharing. See, e.g., *Lee*, page 7, ¶¶[0065]-[0067]; Fig. 2. In the Final Office Action, the Examiner states that *Lee* teaches communicating active content using a chat module communications path. See Final Office Action, p.5 (stating that *Lee*, Fig. 2 (30) is a chat module communications path). However, as is evident from a close reading of *Lee*, Fig. 2 (30) is **NOT** a chat module communications path, contrary to the Examiner's continued insistence. Figure 2 shows a communications network 60 and a separate, high-bandwidth network 70. Figure 2 (30) is the path through the high-bandwidth network 70, **NOT** the chat module communications path through communications network 60.

For example, *Lee* does not disclose sending active content using a chat module communications path between first and second chat modules, as called for in claim. In fact, *Lee* is explicit that active content communications between chat modules would not work and proposes a solution that is entirely different from providing active content using a chat module

communication path. *See Lee*, page 7, ¶¶[0065]-[0067]. *Lee* is directed to a file sharing system to share content using multiple communication paths, *i.e.*, a communication path that is separate and distinct from communication path that links chat modules. The communications in *Lee* is between an inviter computer and an invitee computer. *Lee* discloses an “online message path” that is used to attempt to establish a separate communications path for content sharing. *See Lee*, page 7, ¶[0066]. *Lee* is explicit that the inviter computer attempts to set up a separate path for content sharing, and this path may be a “point-to-point tunneling protocol.” *See Lee*, page 7, ¶¶[0064-0066]. The separate, second port used for content sharing session is “a second communication path” that is “defined between the identified port and the invitee computer.” *See Lee*, page 7, ¶[0067]. This second communication path of *Lee* is not a chat module communication path and is clearly distinguishable from the communication path that is used for chat communications. Accordingly, *Lee* fails to disclose sending active content using a chat module communications path between first and second chat modules, as called for in claim 1.

Lee very clearly teaches using one communication path for chat communications, and a separate communication path for sending content. For example, Appellant respectfully directs the Examiner’s attention to Figure 2 and ¶¶[0065]-[0067] of *Lee*. Figure 2 of *Lee* shows a chat messaging communications path between client computers 20a and 20b and servers 10a and 10b. This communications path is used for messaging communications between these devices. *See, e.g., Lee*, Fig. 2 & ¶¶[0037]-[0038]. *Lee*, however, discloses a separate communications path for the transfer of content data. *See Lee*, Fig. 2 (30) & ¶¶[0065]-[0067] (stating “if the inviter computer determines at step 908 that the invitee has accepted the invitation, then the inviter computer attempts to establish a content sharing session on a **second, or “content sharing,” communication path 30** (see FIG. 2), between the inviter computer and the invitee computer.”) (*emphasis added*). *Lee* teaches that the messaging application **does not** transfer content over the messaging communication path, rather a “second,” separate connection (30) must be made to accommodate the high-bandwidth content transfer. It should be noted that the separate connection (30) is point-to-point and does **not** pass through the web/communications servers 10a/10b. This is because the separate connection (30) is **not** utilized by the messaging module, as can be seen by a complete reading of *Lee*.

Lee is explicit in disclosing that an “online message service” with “small relatively small amount of bandwidth” is used in setting up the separate communication path for content sharing.

See *Lee*, page 7, ¶[0066]. In other words, the message service is not, itself, capable of transmitting content to another client. The limited bandwidth capabilities of the message service prevent such a transfer. As taught in *Lee*, a *separate port* (and connection) is utilized to transfer content, not the port on which the online messenger service is “communicating.” See *id.* The system disclosed by *Lee* makes it impossible to perform the active content communication between chat modules called for in claim 1. Accordingly, *Lee* actually directs one away from the subject matter of claim 1. Because *Lee* discloses a separate path due to its limited bandwidth capabilities, *Lee* teaches a completely different way of sharing/sending information. *Lee* teaches a separate action altogether. This is in stark contrast to the chat modules called for by claim 1, which provide for sending and receiving the active content of a sender peer using a chat module communications path between first and second chat modules, as called for by the claim 1. Because *Lee* explicitly indicates that the active content communication between chat modules is impossible due to bandwidth constraints, and describes sending content on an entirely separate and distinct communication path, it necessarily follows that *Lee’s* system is entirely different from the one called for by claim 1. Thus, *Lee* cannot anticipate this feature of claim 1.

Moreover, *Lee* discloses providing content to a recipient using an entirely different network. *Lee* discloses that the peer-to-peer connection path 30 goes through a network 70. See *Lee*, Fig. 2. The network 70 is separate and distinct from the communications network 60 used by the messaging applications of clients 20a/20b. Thus, not only does *Lee* fail to disclose using the chat module communication path to perform chat communication as well as send active content, *Lee* goes so far as to teach content being sent on an entirely different network. *Lee’s* disclosure fails to teach using the same network for sending content, much less sending content on the same communication path as the chat communication. For at least these reasons, *Lee* does not teach all elements of the claims.

Respectfully submitted,

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Date: Sept. 30, 2009

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